

1 KEKER & VAN NEST LLP
2 ROBERT A. VAN NEST - # 84065
3 rvannest@kvn.com
4 CHRISTA M. ANDERSON - # 184325
5 canderson@kvn.com
6 DANIEL PURCELL - # 191424
7 dpurcell@kvn.com
8 633 Battery Street
9 San Francisco, CA 94111-1809
10 Telephone: (415) 391-5400
Facsimile: (415) 397-7188

7 KING & SPALDING LLP
8 BRUCE W. BABER (pro hac vice)
9 bbaber@kslaw.com
10 1180 Peachtree Street, N.E.
Atlanta, Georgia 30309-3521
Tel: (404) 572-4600
Fax: (404) 572-5100

11 Attorneys for Defendant
12 GOOGLE INC.

13 UNITED STATES DISTRICT COURT
14 NORTHERN DISTRICT OF CALIFORNIA
15 SAN FRANCISCO DIVISION

16 ORACLE AMERICA, INC.,

17 Plaintiffs,

18 v.
19 GOOGLE INC.,
20 Defendant.

Case No. 3:10-cv-03561 WHA
**DEFENDANT GOOGLE INC.'S
RESPONSE REGARDING PROPOSED
INSTRUCTIONS RE FACTOIDS (ECF
NO. 1711)**

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Dept.: Courtroom 8, 19th Fl.
Judge: Hon. William Alsup

1 Defendant Google Inc. (“Google”) respectfully submits this response to the request
 2 contained in the Court’s April 21, 2016 Proposed Instructions Re Factoids From Court Of
 3 Appeals Opinion. ECF No. 1711.

4 In its April 21 order, the Court proposed two pairs of statements to be read to the jury that
 5 are based on the Federal Circuit’s opinion. The first pair consisted of a statement, favorable to
 6 Oracle, regarding the commercial nature of Google’s use of the declaring code and SSO (the
 7 “Commercial Statement”) and a statement, favorable to Google, regarding the Java programming
 8 language (the “Java Language Statement”). The second pair consisted of a statement favorable to
 9 Oracle regarding Java compatibility (the “Compatibility Statement”) and a statement regarding
 10 both the licensing of Java ME and Sun/Oracle’s smartphone development failures (the “Java ME /
 11 Smartphone Statement”).

12 Google advised the Court (and Oracle) in Google’s noon filing yesterday, ECF No.
 13 1727-1 at 2, 4-5, that Google was prepared to agree that the Court could read to the jury the first
 14 pair of statements, as well as the Compatibility Statement and the second sentence of the Java
 15 ME / Smartphone Statement—but not the first sentence of the Java ME / Smartphone Statement.

16 As Google explained in its filing yesterday, ECF No. 1727-1 at 4-5, the first portion of the
 17 Java ME / Smartphone Statement—“Oracle licensed Java ME for use on feature phones and
 18 smartphones.”—is vague, general, and potentially misleading. The Java ME statement says
 19 nothing about which Java ME product or products were licensed, and provides no information
 20 regarding the parties to whom any such licenses were granted, the scope of any such licenses,
 21 when any such licenses were entered into, the terms of any such licenses, the purposes for which
 22 any such licenses were entered into, any “smartphones” with respect to which the statement is
 23 true, or whether or to what extent any such licenses were in fact exploited by the licensees.

24 The evidence at trial, moreover, will show that Java ME—which is very different from the
 25 Java SE works that are at issue—was never licensed for use in a modern smartphone like those in
 26 which Android is used as the operating system, and that Java ME lacks the capability to support
 27 such a use. As Google noted in yesterday’s filing, ECF No. 1727-1 at 4-5, the testimony of
 28 Oracle’s claimed “employee expert” Henrik Stahl supports Google’s position, and confirms that

1 Java ME, with only 10 API packages, lacks the capability to support a modern smartphone
 2 platform. These facts show not only why Android transformed the Java SE APIs, but also why
 3 Oracle's claim of market harm fails. Reading the Java ME statement to the jury would therefore
 4 create a risk of significant juror confusion with respect to the evidence that will be offered on
 5 several fair use factors.

6 In view of the above, the Java ME statement is at best of limited value and, based on the
 7 evidence that Google expects will be introduced at trial, would likely be of no probative value at
 8 all. Google therefore was willing to agree that the Court could read the two pairs of statements to
 9 the jury, but without the first sentence of the Java ME / Smartphone Statement.¹

10 Oracle, however, did not agree to Google's proposal to delete the first sentence of the Java
 11 ME / Smartphone Statement. Based on the communications it received from Oracle, Google
 12 understands that Oracle's final position is that Oracle would agree that only the Compatibility
 13 Statement could be read to the jury as drafted, that it wished to edit both the Commercial
 14 Statement and the Java ME / Smartphone Statement to add language favorable to Oracle, that it
 15 was not agreeable to the deletion of the first sentence of the Java ME / Smartphone Statement,
 16 and that it would only agree that the first sentence of the Language Statement could be read.

17 Google is not willing to agree to Oracle's proposals. As a result, the parties have not been
 18 able to stipulate that the Court's proposed instructions should be given.

19 Google continues to believe that, for the reasons stated above, the first sentence of the
 20 Java ME / Smartphone Statement should not be read to the jury. Google also continues to
 21 believe, as the Court stated in the order containing its proposed instructions, that any instructions
 22 to the jury based on factoids or language in the Federal Circuit opinion should be balanced and
 23 even-handed, and should "give both sides the benefit of favorable points" from the opinion.

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 26 ¹ As noted above, the Java ME / Smartphone Statement is in fact comprised of two separate
 27 statements, one of which (the first sentence regarding Java ME licensing) favors Oracle, and the
 28 second of which (the second sentence regarding Sun/Oracle's development failures) favors
 Google. As a result, including the Java ME statement as drafted would be inconsistent with the
 "even-handed" approach outlined by the Court in its order regarding the proposed instructions.
 ECF No. 1711 at 1, 2.

1 DATED: April 26, 2016

KEKER & VAN NEST LLP

2 By: /s/ Robert A. Van Nest
3 ROBERT A. VAN NEST

4 Attorneys for Defendant
5 GOOGLE INC.

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